Amendment and Response under 37 C.F.R. 1.116
Applicant: Micheal Talley et al.
Serial No.: 10/718,179
Filed: November 20, 2003
Docket No.: 200309402-1
Title: METHOD FOR EDITING A PRINTED PAGE

REMARKS

The following remarks are made in response to the Final Office Action mailed January 28, 2008. Claims 1-4, 6, 7, 9-19, 23, and 24 were rejected while claim 8 was indicated to be allowable if presented in independent form. With this Response, claims 2 and 23 have been canceled, claims 1, 3-4, 6-19, and 24 have been amended, and new claim 25 has been added. Claims 1, 3-4, 6-19, and 24-25 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 112

In the Office Action, claim 11 was rejected under 35 U.S.C. 112, first paragraph, as being indefinite and for failing to comply with the written description requirement regarding the limitation "without regard to position information on the printed document" in claim 11. Claim 11 has been amended to omit this limitation, thereby obviating the rejection and therefore, withdrawal of the rejection is respectfully requested.

Claim Rejections under 35 U.S.C. § 103

In the Office Action, claims 1, 10-14, 16-18, 23, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis US Patent 5,870,624 (the Kikinis Patent) in view of the Frank US Patent 3,611,291 (the Frank Patent).

Dependent claim 23 has been canceled.

Applicants' independent claim 1 recites a method of editing, independent and separate of a computer, a printed page comprising (among other things) electronically and automatically modifying, <u>exclusively</u> via the multifunction printer and <u>independent of and separate from a text-based word processing program</u>, the first page description file using the at least one electronic edit instruction to create a second page description file (that includes the text modified according to the at least one <u>standard</u> handwritten edit symbol).

In sharp contrast to the assertion in the Office Action that the Kikinis Patent (citing to the Ahne Patent) discloses editing of a page description file, Applicants respectfully submit that the page description files recited in Applicants' claim 1 (as understood by those skilled in the art and as explained in Applicants' specification in at least Paragraph 14 in Applicants' corresponding U.S. Patent Publication 2005/0114772) are not equivalent to a text file

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manually editable via conventional word processing programs as described in the Kikinis Patent.

In addition, the citation to the Ahne Patent merely identifies various types of files (such as PCL using ASCII characters) are stored in a memory of printer in a form usable by the printer but that does not convert an ASCII text file editable via a word processing program (as referred to in the Kikinis Patent) into a page description file. The Ahne Patent itself makes this distinction at Column 4, 38-48. Accordingly, the fact that ASCII characters may be used for both types of files does not negate the substantial differences between a page description file and a text file editable by a conventional word processing program. Accordingly, even with the help of the Ahne Patent, the Kikinis Patent fails to teach scanning and editing a page description file and instead the Kikinis Patent teaches scanning a page and then manually editing a text file via a word processor. Moreover, this non-equivalence (between a page description file in Applicants' claim and a text-based file editable via a word processor in the Kikinis Patent) is of particular interest in that Applicants' method recites automatically modifying (exclusively via the multifunction printer independent of a computer) the first page description file to create a second page description file. This feature of automatic modification is enhanced due to the device-independent nature of the page description file and the page description file being automatically and directly editable at the multifunction printer without user participation (as would otherwise be conventionally performed via a word processing program using a computer). Applicants further note in this regard that the Ahne Patent teaches manual editing via a user interface.

Moreover, while the Kikinis Patent discloses integrating an I/O device into a desktop computer (see, for example, at least Column 1, lines 52-62 and Column 4, lines 6-12, 35-37, 64-67), the result is still not equivalent to and does not reasonably make obvious Applicants' method using a multifunction printer because the desktop computer will include many more resources, while being more expensive and bulkier than the multifunction printer (of Applicants' claim 1). In particular, the multifunction printer in Applicants' claimed method performs the automatically editing of a page description file, while requiring substantially less computing power and fewer memory resources, both of which reduce the cost and size of the multifunction printer (relative to the cost of a desktop computer modified to additionally include a printing/scanning I/O device as taught by the Kikinis Patent).

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In addition, because the Kikinis Patent describes editing a page by using a word processor to edit a text-based file, the Kikinis Patent fails to disclose electronically identifying an electronic edit instruction corresponding to at least one standard handwritten edit symbol (from a scanned page) and electronically (and automatically) modifying the first page description file (not a text-based file editing via a conventional word processor) into a second page description file to implement the at least one electronic edit instruction.

The Frank Patent fails to cure the deficiencies of the Kikinis Patent, as the Frank Patent fails to disclose (among other things) a method of editing a page independent of, and separate from, a computer with the method comprising automatically modifying a first page description file, exclusively via a multifunction printer and independent of and separate from text-based word processing program, using an electronic edit instruction corresponding to at least one standard handwritten edit symbol, as recited in Applicants' independent claim 1.

Instead, the Frank Patent discloses that the system includes a scanning unit 74 for optically scanning a sheet and connected to (and in communication with) a master control unit 86, as illustrated in Figure 5. See, for example, Column 5, lines 50-70. This master control unit 86 is a general purpose digital computer (see, for example, Column 11, lines 20-25) which provides storage of character-related information (among other data) and execution of instructions to implement the editing of a sheet according to the handwritten symbols. See, for example, Column 3, lines 50-55; Column 11, lines 26-50; Column 14, line 74 – Column 15, line 32; and Column 15, lines 60-65. Accordingly, the Frank Patent fails to disclose a method of editing a page that is independent of, and separate from, a computer as recited in Applicants' independent claim 1.

Moreover, the Frank Patent fails to disclose a method of editing a page in which a page description file is automatically modified into a second page description file using an electronic edit instruction corresponding to at least one standard handwritten edit symbol, as recited in Applicants' independent claim 1. Instead, the Frank Patent discloses a complex scanning/recognition technique (see Column 5, line 50 – Column 14) that is much more cumbersome than scanning and editing a page description file in the manner described in Applicants' specification and as claimed in Applicants' claim 1, as recognized by those skilled in the art.

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Moreover, the Frank Patent relies on an elaborate system of editing symbols involving various combinations of vertical and horizontal lines, with each different combination expressing a different editing instruction. See, for example, Figures 1-2 and 4 and the accompany description in at least Columns 2-5. However, it is readily apparent that this editing paradigm would not be known to the typical editor. On the other hand, most editors and other writing professionals are already familiar with standard edit symbols made by the handwriting of the editor/writer, such as the paragraph symbol (¶), the strikethrough symbol, the spelling symbol (sp), etc. Not coincidentally, Applicants' specification identifies these standard handwriting edit symbols (see, for example, elements 15 in Figure 1 and in at least Paragraph 11 of Applicants' U.S. Patent Publication 2005/0114772). Because Applicants' method permits scanning and recognition of electronic edit instructions corresponding to these standard handwritten edit symbols, editing a page with Applicants' method is substantially more convenient and effective for most people since they do not have to learn a new elaborate/complex paradigm of editing symbols, such as the one described in the Frank Patent. One skilled in the art would readily appreciate the advantages of Applicants' method over the cumbersome techniques used to implement the editing scheme of the Frank Patent and therefore the Frank Patent teaches away from Applicants' method recited in claim 1.

Accordingly, the Frank Patent fails to disclose (among other things): (1) electronically identifying from the scanned printed page, exclusively via the multifunction printer, at least one electronic edit instruction, which corresponds to the at least one **standard** handwritten edit symbol; and (2) electronically and **automatically** modifying, exclusively via the multifunction printer and independent of text-based word processing, the first page description file using the at least one electronic edit instruction to reflow the first page description file to create a second page description file that includes the text modified according to the at least one **standard** handwritten edit symbol.

Consequently, one skilled in the art attempting to combine the Kikinis Patent and the Frank Patent would not arrive at Applicants' claim 1.

For at least these reasons, the Kikinis Patent and the Frank Patent fail to teach, suggest, or reasonably make obvious Applicants' amended independent claim 1, and therefore Applicants' amended independent claim 1 is patentable and allowable over the

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Kikinis Patent and the Frank Patent. Dependent claim 10 is believed to be allowable because it further defines patentably distinct independent claim 1.

For at least substantially the same reasons presented for the patentability of independent claim 1, the Kikinis Patent and the Frank Patent fail to teach, suggest, or reasonably make obvious the features recited in Applicants' independent claim 11 that provides a method of using a multifunction printer to automatically edit a document. In particular, the Kikinis Patent and the Frank Patent fail to teach, suggest, or reasonably make obvious a method of using a multifunction printer including (among other things): (1) electronically and automatically identifying, via the scanned printed document, the at least one **standard** handwritten edit symbol on the printed document; (2) electronically and automatically determining at least one electronic edit instruction corresponding to at least one **standard** handwritten edit symbol; and (3) electronically and automatically applying, to the first electronic printable file, the at least one electronic edit instruction to create a second electronic printable file including modified text of the printed document.

Consequently, one skilled in the art attempting to combine the Kikinis Patent and the Frank Patent would not arrive at Applicants' claim 11.

For at least these reasons, the Kikinis Patent and the Frank Patent fail to teach, suggest, or reasonably make obvious Applicants' amended independent claim 11, and therefore Applicants' amended independent claim 11 is patentable and allowable over the Kikinis Patent and the Frank Patent. Dependent claims 12 and 24 are believed to be allowable as they further define patentably distinct independent claim 11.

For at least substantially the same reasons presented for the patentability of independent claims 1 and/or 11, the Kikinis Patent and the Frank Patent fail to teach, suggest, or reasonably make obvious the features recited in Applicants' independent claim 13 that provides a multifunction printer. In particular, the Kikinis Patent and the Frank Patent fail to teach, suggest, or reasonably make obvious a multifunction printer including (among other things): (1) an optical recognition function configured to perform an optical character recognition on the electronic image file to recognize **on the at least one printed page**, **the at least one standard handwritten edit symbol**; and (2) an edit manager stored in a memory

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and configured, in communication with the optical recognition function, to **automatically** implement an electronic edit instruction corresponding to the at least one standard handwritten edit symbol to the first page description file to create a second page description file that includes the text modified according to the at least one **standard** handwritten edit symbol, wherein the edit manager implements the electronic edit instruction at the multifunction printer independent of, and separate from, a computer.

Consequently, one skilled in the art attempting to combine the Kikinis Patent and the Frank Patent would not arrive at Applicants' claim 13.

For at least these reasons, the Kikinis Patent and the Frank Patent fail to teach, suggest, or reasonably make obvious Applicants' amended independent claim 13, and therefore Applicants' amended independent claim 13 is patentable and allowable over the Kikinis Patent and the Frank Patent. Dependent claims 14 and 16-18 are believed to be allowable as they further define patentably distinct independent claim 13.

In the Office Action, claims 2-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the Kikinis Patent and the Frank Patent as applied to claim 1, and further in view of Ericson et al. US Patent Application Publication No. 2002/0054778 (the Ericson Publication). In the Office Action, claims 6 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the Kikinis Patent, the Frank Patent, and the Ericson Publication as applied to claims 1 and 2, and further in view of Yano et al. US Patent 6,910,184 (the Yano Patent). In the Office Action, claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the Kikinis Patent and the Frank Patent as applied to claim 1, and further in view of the Yano Patent.

Claim 2 was canceled and dependent claims 3-4, 6-7, and 9 are believed to be allowable because they further define patentably distinct independent claim 1.

In the Office Action, claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the Kikinis Patent and the Frank Patent as applied to claim 13, and further in view of Kanematu US Patent 7,130,066 (the Kanematu Patent). In the Office Action, claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the Kikinis Patent and the Frank Patent as applied to claim 13, and further

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in view of Minami et al. US Patent Application Publication No. 2004/0141200 (the Minami Publication).

Dependent claims 15 and 19 are believed to because they further define patentably distinct independent claim 13.

In light of the above, Applicants respectfully request withdrawal of the above rejections of claims 1-4, 6-19, and 23-24 under 35 U.S.C. §103 and respectfully request allowance of these claims.

Allowable Subject Matter

In the Office Action, clam 8 was objected to and indicated to be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

Applicants have presented the subject matter of "objected to" claim 8 in independent claim 25, which includes the limitations of the base claim 1 and intervening claim 2 while also insuring antecedent basis and eliminating redundant terminology. Accordingly, Applicants respectfully request allowance of new independent claim 25. Applicants note that taking allowable subject matter in new independent claim 25 raises no new issues and does not require an additional searching.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1, 3-4, 6-19, and 24-25 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1, 3-4, 6-19, and 24-25 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Paul S. Grunzweig at Telephone No. (612) 767-2504, Facsimile No. (612) 573-2005 or Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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